

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 020431.0742

In re Application of:

JAMES M. CRAWFORD, ET AL.

Serial No. **09/675,415**

Filed: 29 SEPTEMBER 2000

For: **SYSTEM AND METHOD FOR
RENDERING CONTENT ACCORDING
TO AVAILABILITY DATA FOR
ONE OR MORE ITEMS**

[illegible]

Examiner:

RAQUEL ALVAREZ

Art Unit: 3688

Confirmation No. 9669

REPLY BRIEF

MAIL STOP: APPEAL BRIEF - PATENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

In response to the Examiner's Answer dated January 22, 2010, Appellants now submit the following Reply Brief pursuant to 37 C.F.R. § 41.41.

REMARKS/ARGUMENTS

This Reply Brief is in response to the Examiner's Answer dated 22 January 2010. There are many different grounds why the Board should reverse the Examiner's Final Rejection of 31 August 2009, as explained fully in Appellants Appeal Brief of 30 November 2009. This Reply Brief highlights for the Board several particular claim elements that are plainly missing from the *Cragun* and *Linden* reference. These missing features require reversal of the anticipation and obviousness rejections.

A. Claims 1, 4-5, 8-13, 15, 18-19, 22-27, 29-30, 33-34, and 37-42

1. The *Cragun* Reference Fails to Disclose a Rules Engine

Cragun's system, as explained in the *Cragun* reference, does not expressly disclose or inherently require a rules engine that generates an availability request corresponding to a rule within the user-requested content concerning the item, receive availability data of the item, or retrieve additional content according to the availability data of the item, the additional content selected from among stored content elements that concern the item, as required by Claim 1. The *Cragun* reference thus lacks at least these features and therefore cannot anticipate Claim 1.

i. *Cragun* Lacks a Rules Engine for Generating an Availability Request Corresponding to a Rule within the User-Requested Content Concerning the Item

Cragun's automated sales promotion selection system is defined at least at column 3, line 66 through column 4, line 27 of the *Cragun* reference. Page 7 of the Examiner's Answer argues

that the *Cragun* reference teaches that the user request to purchase an item is sent to a server in order for the request to be fulfilled.

However, *Cragun*'s automated sales promotion selection system (mapped by the Examiner to the rules engine) lacks rules for generating an availability request. Without rules specifically within the user-requested content concerning the item for generating an availability request, the *Cragun* reference cannot anticipate Claim 1.

With respect to the *Cragun* reference, the Examiner's Answer blurs the distinction between what is disclosed in the *Cragun* reference and what may be disclosed in the *Cragun* reference. For example, it appears that the Examiner's Answer may be contending that the above-quoted claim language is met with a possibility that the *Cragun* reference may inherently disclose rules for generating an availability request and that the *Cragun* reference teaches the user request to purchase an item is sent to a server in order for the request to be fulfilled. However, "[i]nherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-US.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)). Appellants are unable to discern from the *Cragun* reference that rules within the user-requested content concerning the item for generating an availability request are necessarily present in the *Cragun* reference, "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Hansgird v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939), quoted in *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

In view of the above, Appellants respectfully submit that *Cragun*'s automated sales promotion selection system expressly or inherently lacks the claimed rules within the user-

requested content concerning the item for generating an availability request. Furthermore, Appellants respectfully submit that the attempts to show that the *Cragun* reference teaches that the user request to purchase an item is sent to a server in order for the request to be fulfilled are flawed because, *Cragun*'s system is concerned with a post processing of customer data after the customer already purchases an item, that is, *Cragun*'s customer does not expressly or inherently make a "user request to purchase an item," as contended in the Examiner's Answer, nor can the request be fulfilled, for at least the reason that there was never a request made. (*Cragun* reference, column 3, line 66 through column 4, line 27). Therefore, Appellants respectfully submit that the Examiner's rejection based on the *Cragun* reference lacks at least this feature and should be reversed by the Board.

ii. *Cragun* Lacks a Rules Engine for Receiving Availability Data for the Item

Pages 3-4 of the Examiner's Answer argue that the concept of claimed availability data is analogous to the concept of *Cragun*'s in-store data. The Examiner's Answer thus alleges that *Cragun*'s in-store data meets the language of Claim 1. However, the *Cragun* reference lacks availability data for the item needed to satisfy the claim language, "receive availability data for the item." Without availability data for the item, the *Cragun* reference cannot anticipate Claim 1.

The problem with this contention is that it relies on an unreasonable reading of the claim language. Claim 1 makes clear that the claimed availability data is for the item. The express claim language calls for receiving the "availability data for the item." The interpretation advanced in the Examiner's Answer is also unreasonable because it conflicts with the specification. It is improper to read into the claims specific limitations from the specification, the plain and ordinary meaning of a claim term must be consistent with the disclosure. *See*

MPEP § 2111.01. For example, the specification language itself (“availability data for the item”) makes clear that the claimed availability data is for the item. The above-quoted claim language must be construed in light of, and be consistent with the specification. As just demonstrated, the interpretation advanced in the Examiner’s Answer is inconsistent with the specification.

In view of the above, Appellants respectfully submit that *Cragun*’s automated sales promotion selection system expressly or inherently lacks the claimed availability data for the item. Furthermore, Appellants respectfully submit that the construction seemingly advanced in the Examiner’s Answer is flawed because, as discussed above, *Cragun*’s system is concerned with a post processing of customer data after the customer already purchases an item and is unreasonable because it conflicts with the language of the claims and because it contradicts the examples provided in the specification, which guides the interpretation of the claims. Therefore, Appellants respectfully submit that the Examiner’s rejection based on the *Cragun* reference lacks at least this feature and should be reversed by the Board.

iii. *Cragun* Lacks a Rules Engine for Retrieving and Communicating the Additional Content Concerning the item to a Rendering Engine for Incorporation in the User-Requested Content

Page 8 of the Examiner’s Answer argues that the *Cragun* system determines additional items likely to be purchased by the customer. However, *Cragun*’s additional item’s (mapped by the Examiner to the additional content) is not selected from stored content elements according to the availability data for the item to the rendering engine for incorporation in the user-requested content. Without additional content specifically selected from stored content elements according to the availability data for the item to the rendering engine for incorporation in the user-requested content, the *Cragun* reference cannot anticipate Claim 1.

In view of the above, Appellants respectfully submit that *Cragun*'s additional item's expressly or inherently lacks the claimed additional content. Furthermore, Appellants respectfully submit that the construction seemingly advanced in the Examiner's Answer is flawed because, as discussed above, *Cragun*'s system is concerned with a post processing of customer data after the customer already purchases an item. In addition, the availability data for the item is lacking in *Cragun*'s system, because, the customer has already purchased the item. Therefore, Appellants respectfully submit that the Examiner's rejection based on the *Cragun* reference lacks at least this feature and should be reversed by the Board.

2. The *Cragun* Reference Fails to Disclose a Rendering Engine

Cragun's system, as explained in the *Cragun* reference, does not expressly disclose or inherently require a rendering engine that identifies at least one rule within the user-requested content and concerning the item or renders the user-requested content, including the additional content concerning the item that has been retrieved according to the availability data of the item and selected from among one or more stored content elements that concern the item, as required by Claim 1. The *Cragun* reference thus lacks at least these features and therefore cannot anticipate Claim 1.

i. *Cragun*'s Lacks a Rendering Engine for Identifying Rules

Cragun's output device is defined at least at column 4, lines 18-27 of the *Cragun* reference. Pages 3-4 of the Examiner's Answer argues that the *Cragun* reference teaches a rendering engine.

However, *Cragun*'s output device (mapped by the Examiner to the rendering engine) lacks identifying rules within the user-requested content and concerning the item and rendering

the user-requested content. Without identifying rules specifically within the user-requested content concerning the item or rendering the user-requested content, the *Cragun* reference cannot anticipate Claim 1.

It appears that the Examiner's Answer may be contending that the above-quoted claim language is met when *Cragun*'s output device generates a purchase suggestion, dispenses a coupon, or other sales promotion. The problem with this contention is that it is inconsistent with the disclosure of the *Cragun* reference. For example, the *Cragun* reference makes clear when a customer purchases items, information-collection devices collect information on the purchase and communicate the collected information to a computer system that then analyzes the collected information on the customer's purchased items to identify possible missing items. The identified items become the subject of a sales promotion that an output device communicates to the customer.

In view of the above, Appellants respectfully submit that *Cragun*'s output device expressly or inherently lacks the claimed rendering engine. Furthermore, Appellants respectfully submit that the attempts to show that the *Cragun* reference teaches that the output device involves a request that is later fulfilled is flawed because, *Cragun*'s customer's purchase is complete at the time of the transaction. (*Cragun* reference, column 4, lines 18-27). Therefore, Appellants respectfully submit that the Examiner's rejection based on the *Cragun* reference lacks at least this feature and should be reversed by the Board.

B. Claims 6-7, 14, 20-21, 28, 35-36, and 43

In view of Appellants arguments with respect to Appellants independent claims, Appellants respectfully submit that the *Cragun* reference expressly or inherently lacks the

claimed elements as recited in dependent claims 6-7, 14, 20-21, 28, 35-36, and 43. Therefore, dependent Claims 6-7, 14, 20-21, 28, 35-36, and 43 are allowable over *Cragun* for at least the reasons of depending from an allowable claim. Therefore, Appellants respectfully submit that the Examiner's rejection based on the *Cragun* reference lacks at least these feature and should be reversed by the Board.

C. Claims 2, 16, and 31

1. The *Cragun* Reference Fails to Disclose a Web Server

Claim 2 recites, *inter alia*, that the server configured to receive a content request from a user in a current interactive session “comprises a web server and the user-supplied content request comprises a Hypertext Transfer Protocol (HTTP) request containing a Uniform Resource Locator (URL) for a particular web page.”

With respect to *Cragun*, the Examiner's Answer agrees with Appellants observations that the *Cragun* reference lacks a web server and a user-supplied content request comprising a HTTP request containing a URL for a particular web page, as required by Appellants claims. The Examiner's Answer nonetheless blurs the distinction between the lack of disclosure in the *Cragun* reference and the alleged disclosure in the *Linden* reference.

For example, it appears that the Examiner's Answer may be contending that the above-quoted claim language is met by including the teaching of the *Linden* reference to “provide world wide access to the system.” However, the problem with this contention is that it relies on an unreasonable reading of the *Linden* reference. Nowhere does the Examiner Answer demonstrate that the *Cragun* reference, the *Linden* reference, or knowledge generally available to a person having ordinary skill in the art at the time of the invention provide any teaching,

suggestion, or motivation whatsoever to make the proposed combination. The Examiner's Answer simply asserts that combining the system of *Linden* with the system of *Cragun* "would provide world wide access to the system," without demonstrating that such a teaching, suggestion, or motivation can be found in the *Cragun* reference, the *Linden* reference, or knowledge generally available to a person having ordinary skill in the art at the time of the invention.

Moreover, nowhere does the Examiner's Answer demonstrate that a person having ordinary skill in the art at the time of the invention would have reasonably expected the proposed combination to achieve the purported results. First, the Examiner fails to demonstrate that the proposed combination would have in fact achieved the purported results. Nowhere does the Examiner's Answer even attempt to demonstrate that combining the system of *Linden* with the system of *Cragun* would actually "provide world wide access to the system," as the Examiner alleges. Second, even assuming for the sake of argument that the proposed combination would have produced the purported results, which Appellants do not concede, the Examiner's Answer fails to demonstrate that a person having ordinary skill in the art at the time of the invention would have reasonably expected such results. The Examiner's Answer merely asserts that combining the system of *Linden* with the system of *Cragun* "would provide world wide access to the system," without demonstrating that a person having ordinary skill in the art at the time of the invention would have reasonably expected such results.

In view of the above, Appellants respectfully submit that the *Cragun* reference or the *Linden* reference expressly or inherently lacks the claimed server configured to receive a content request from a user in a current interactive session comprising a "web server and the user-supplied content request comprises a Hypertext Transfer Protocol (HTTP) request containing a

Uniform Resource Locator (URL) for a particular web page. Therefore, Appellants respectfully submit that the Examiner's rejection based on the proposed combination of the *Cragun* reference and the *Linden* reference lacks at least this feature and should be reversed by the Board.

D. Claims 3, 17, and 32

1. The *Cragun* Reference Fails to Disclose a Container in a Web Page

Claim 3 recites, inter alia, that the “user-requested content is a particular web page comprising a container that contains the rule” and that the “additional content concerning the item is incorporated into the web page to replace the container.”

With respect to *Cragun*, the Examiner's Answer agrees with Appellants observation that the *Cragun* reference lacks user-requested content that is a web page comprising a container that contains the rule and that the additional content concerning the item is incorporated into the web page to replace the container, as required by Appellants claims. The Examiner's Answer nonetheless blurs the distinction between the lack of disclosure in the *Cragun* reference and the alleged disclosure in the *Linden* reference.

For example, it appears that the Examiner's Answer may be contending that the above-quoted claim language is met by including the teaching of the *Linden* reference to “allow for the convenience of allowing for the rules to be requested when necessary.” However, the problem with this contention is that it relies on an unreasonable reading of the *Linden* reference. Nowhere does the Examiner Answer demonstrate that the *Cragun* reference, the *Linden* reference, or knowledge generally available to a person having ordinary skill in the art at the time of the invention provide any teaching, suggestion, or motivation whatsoever to make the proposed combination. The Examiner's Answer simply asserts that combining the system of

Linden with the system of *Cragun* “would allow for the convenience of allowing for the rules to be requested when necessary,” without demonstrating that such a teaching, suggestion, or motivation can be found in the *Cragun* reference, the *Linden* reference, or knowledge generally available to a person having ordinary skill in the art at the time of the invention.

Moreover, nowhere does the Examiner’s Answer demonstrate that a person having ordinary skill in the art at the time of the invention would have reasonably expected the proposed combination to achieve the purported results. First, the Examiner fails to demonstrate that the proposed combination would have in fact achieved the purported results. Nowhere does the Examiner’s Answer even attempt to demonstrate that combining the system of *Linden* with the system of *Cragun* would actually “allow for the convenience of allowing for the rules to be requested when necessary,” as the Examiner alleges. Second, even assuming for the sake of argument that the proposed combination would have produced the purported results, which Appellants do not concede, the Examiner’s Answer fails to demonstrate that a person having ordinary skill in the art at the time of the invention would have reasonably expected such results. The Examiner’s Answer merely asserts that combining the system of *Linden* with the system of *Cragun* “would allow for the convenience of allowing for the rules to be requested when necessary,” without demonstrating that a person having ordinary skill in the art at the time of the invention would have reasonably expected such results.

In view of the above, Appellants respectfully submit that the *Cragun* reference or the *Linden* reference expressly or inherently lacks the claimed user-requested content that is a web page comprising a container that contains the rule and that the additional content concerning the item is incorporated into the web page to replace the container. Therefore, Appellants respectfully submit that the Examiner’s rejection based on the proposed combination of the

Cragun reference and the *Linden* references lacks at least this feature and should be reversed by the Board.

CONCLUSION

In view of the missing claim elements argued above, reversal of the Final Rejection and a Notice of Allowance are respectfully requested.

Although Appellants believe no additional fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

22 March 2010
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

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